

REMARKS

I. Status of the Claims

In the Office Action¹ mailed July 16, 2010, the Examiner took the following actions:

- (i) rejected claim 1 under 35 U.S.C. § 101;
- (ii) rejected claims 1-6, 8-21, 23-29, and 31-47 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 7,546,537 B2 to Crawford ("*Crawford*"); and
- (iii) rejected claims 7, 22, 30, and 48 under 35 U.S.C. § 103(a) as being unpatentable in view of *Crawford* and *Official Notice*.

By this Amendment, Applicants amend claims 1, 5-8, 10, 26, and 28-32. No prohibited new matter has been added. Claims 1-48 remain pending. For at least the following reasons, Applicants submits that the pending claims are in condition for allowance.

II. Rejection of Claim 1 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claim 1 under 35 U.S.C. § 101. Method claim 1 is clearly directed to a statutory subject matter under the Supreme Court's guidance in *Bilski*, and does not encompass abstract ideas or other non-statutory subject matter. In order to advance prosecution, however, Applicants amend independent claim 1 to clarify that the claim encompasses a "computer-implemented method" that includes certain steps performed "by a processor." For at least these

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

reasons, claim 1 is directed to statutory subject matter and the rejection under 35 U.S.C. § 101 should be withdrawn.

III. Rejections of Claims 1-6, 8-21, 23-29, and 31-47 under 35 U.S.C. § 102(a)

Applicants respectfully traverse the rejections of claims 1-6, 8-21, 23-29, and 31-47 under 35 U.S.C. § 102(a) as being anticipated by *Crawford*, at least because *Crawford* does not qualify as prior art with respect to Applicants' application.

The present application was filed by Applicants on May 17, 2005² and claims priority from International Application No. PCT/US03/36794, filed on November 18, 2003 and U.S. Provisional Application No. 60/426,813, filed on November 18, 2002. In view of these applications, the effective priority date of Applicants' application is November 18, 2002.

Crawford was published on June 9, 2009, which is after Applicants' priority date of November 18, 2002. Accordingly, *Crawford* does not qualify as prior art against Applicants' application under 35 U.S.C. § 102(a). Moreover, for obvious reasons, *Crawford* also does not qualify as prior art under 35 U.S.C. § 102(b).

In view of the foregoing, *Crawford* is not prior art with respect to Applicants' application and the rejection of claims 1-6, 8-21, 23-29, and 31-47 under 35 U.S.C. § 102(a) is improper and should be withdrawn.

² Applicants' application was filed as a national stage entry of PCT/US03/36794 on May 17, 2005 and within the 30-months of the November 18, 2003, filing date of PCT/US03/36794. On April 20, 2007 Applicants submitted a Declaration, thus completing the requirements under 35 U.S.C. 371. However, by entering the national stage within 30 months of November 18, 2003 the Application maintained its priority to U.S. Provisional Application No. 60/426,813, filed November 18, 2002.

Even assuming that the Examiner intended to reject claims 1-6, 8-21, 23-29, and 31-47 under 35 U.S.C. § 102(e), *Crawford* does not anticipate all of the features of claims 1-6, 8-21, 23-29, and 31-47.

In order to properly establish that a reference anticipates Applicants' claims under 35 U.S.C. § 102, each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131., 8th Ed., Rev. 7 (July, 2008). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)).

Crawford fail to disclose or suggest, all of the features of Applicants' claims including, among other things, "**determining a set of recipient candidates** likely to be interested in the content **based upon the classification of the content and prior sharing activity of the recipients** with respect to content of the same or similar classification," as recited in amended independent claim 1 (emphasis added).

In *Crawford* "client 702b gradually displays the buddy icon sent from another subscriber and affords the opportunity to accept or reject the buddy icon." *Crawford*, col. 13, l. 65 - col. 14, l. 1. Further, in col. 15, ll. 42-49, *Crawford* discloses:

[T]he client 702 a receives a list of the first subscriber's "buddies" that are currently online (i.e., accessing the host 704). Buddies are subscribers or screen names designated for exchanging instant messages. In general, the host 704 informs the first subscriber as to whether designated buddies are online or offline. The host 704 also informs any subscriber that has designated the first subscriber as a buddy that the first subscriber is online.

Thus, in *Crawford* client 702 receives a list of buddies that are currently online and displays buddy icons. The list of buddies of *Crawford*, however, does not constitute

the claimed “set of recipient candidates.” This is at least because the list of buddies in *Crawford* are not “based upon the **classification of the content and prior sharing activity of the recipients** with respect to content of the same or similar classification,” as recited in independent claim 1 (emphasis added). There is no disclosure in *Crawford* of determining a set of recipient candidates based on a classification of content or based on prior sharing activity of buddies. At most, *Crawford* merely discloses displaying a list of users that are currently online.

For at least the foregoing reasons, *Crawford* fails to disclose or suggest each and every feature of independent claim 1 and claim 1 should be allowed over *Crawford*.

Independent claims 26 and 41, although of different scope, recite features similar to those discussed above for claim 1, and therefore are also allowable over the cited references for at least reasons similar to those for claim 1. Further, claims 2-6, 8-21, 23-25, 27-29, 31-40, and 42-47 depend from one of the independent claims, and are also allowable at least due to their dependence from an allowable base claim, and further in view of the additional features of these claims.

IV. Rejections of Claims 7, 22, 30, and 48 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 7, 22, 30, and 48 under 35 U.S.C. § 103(a) because *Crawford* cannot be relied upon as prior art to support the 35 U.S.C. § 103(a) rejection.

35 U.S.C. § 103(c)(1) states that:

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability** under this section **where the subject matter and the claimed invention** were, at the time the claimed invention was made, **owned by the same person or**

subject to an obligation of assignment to the same person. (Emphasis added).

As noted above, *Crawford* does not qualify as prior art against Applicants' application under 35 U.S.C. §§ 102(a) or (b). While *Crawford* may qualify as a reference under 35 U.S.C. § 102(e), *Crawford* was commonly owned with the present application by the same entity or was subject to an obligation of assignment to the same entity at the time of Applicants' application. See *Crawford* assignment recordation, Reel/Frame Nos. 021654/0116 and 023723/0645 and present application assignment recordation, Reel/Frame Nos. 019189/0215 and 023723/0645.

Accordingly, pursuant to 35 U.S.C. § 103(c), *Crawford* cannot be relied upon to reject claims 7, 22, 30, and 48 under 35 U.S.C. § 103(a). Moreover, the *Official Notice* does not render obvious each and every feature of the claims.

Accordingly, for at least the reasons noted above, the Examiner's reliance on *Crawford* in each of the 35 U.S.C. § 103(a) rejections is improper, and the rejection of claims 7, 22, 30, and 48 should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By: 

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